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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,182	01/25/2002	Timothy Alan Scavone	8854	5287

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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,182

Applicant(s)

SCAVONE ET AL.

Examiner

Shengjun Wang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 19, 2004 is acknowledged.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 27 recites "from about 10% to about 90% by weight of a propellant." The application, as originally filed, lacks support to the recited limitation. The application does not provide a sufficient written description of a composition comprising "from about 10% to about 90% by weight of a propellant." See, page 10, and the examples herein in the specification.

Claim Rejections 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (US 5,176,903, IDS), in further view of Berndt (US 5,626,856, IDS) and Putman et al. (US 5,902,571)
3. Goldberg et al. teaches an antiperspirant containing composition comprising 12-30% of “wax”; 10-80% of silicone; 10-30% of antiperspirant salt, wherein the “wax” may be a mixture of various “waxes” including hydrogenated castor oil, and petrolatum (the WAX disclosed by Goldberg would meet the limitation of suspending agents herein, see pages 6-7 in the specification); the silicone may be cyclodimethicone, dimethicone, polydimethylsiloxane, or mixture thereof; the antiperspirants may include aluminum salt, zirconium salt. See, particularly, column 4, lines 35-68. Other ingredients may be incorporated in the composition are silica, PEG distearate. See, particularly, the examples and the claims.
4. Goldberg et al. does not teach expressly the particularly amount of petrolatum herein, or the particular amounts of other ingredients.
5. However, Goldberg et al. discloses generally the usefulness of mixture of the wax material, which would encompass all range of mixing, including the range herein claimed (0.05-0.95% of petrolatum to 0.1 to 30% of suspending agents. Therefore the range herein claimed overlap with the range disclosed by Goldberg.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a antiperspirant containing composition with the particularly amounts of each and every ingredients herein (particularly, the mixture of hydrogenated castor oil and petrolatum).

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A person of ordinary skill in the art would have been motivated to make an antiperspirant containing composition with the particularly amounts of each and every ingredients herein because it is well-settled that In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of “about 1-5%” while the claim was limited to “more than 5%.” The court held that “about 1-5%” allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). As to the employment of C18-C36 triglycerides, note C18-C36 triglycerides are particularly known to be useful in cream formulation of antiperspirant composition. See, particularly, the abstract, column 6, lines 15-39, and the claims in Putman. The employment of white petrolatum is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388) since white petrolatum is known to be useful in antiperspirant composition. See, particularly, the examples in Berndt. Furthermore, the optimization of a result effective parameter, e.g., the amounts of each known ingredients in a cosmetic composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

1. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guskey et al. (US 5,976,514, IDS)

Guskey et al. teaches an antiperspirant composition comprising 0.01% to about 60% by weight of an antiperspirant/deodorant active, 1% to 60% of volatile nonpolar hydrocarbon, and from about 1% to about 60% of a mitigating material, wherein the mitigating material may be

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silicone, petrolatum, etc, or mixture thereof. The composition may be in the form of aerosol. See, particularly, column 11, lines 31 to 38, the claims.

Guskey et al. does not teach expressly to use petrolatum as the mitigating agent therein, or the particular amount of propellant.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ petrolatum as part of the mitigating agent since petrolatum is known to be useful as mitigating agent. The employment of petrolatum is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). Further, the optimization of a result effective parameter, e.g., amounts of propellant in a aerosol composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Also noted that the volatile nonpolar hydrocarbon would meet the limitation as propellant. Finally, the “about 0.95%” herein would read on, or be obvious to the “about 1%” disclosed by Guskey.

Response to the Arguments

Applicants assert that the rejection of claims 1-23 over Goldberg et al. fail to establish a prima facie case of obviousness. Particularly, applicants argue that the claimed invention herein is only one of many possible formulations disclosed by Goldberg. The examiner disagrees. Particularly, Goldberg et al. disclose compositions with the same functions herein claimed. I.e., the claimed invention and Goldberg’s composition have the same properties. Goldberg’s disclosure encompasses the claimed invention here. A prima facie case of obviousness. A prima facie case of obviousness would be established if the claimed invention and the prior art is subgenus/ genus, and the claimed invention would have the properties disclosed by the prior art.

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Applicants further argue that Goldberg et al. does not teach the particular amount of petrolatum. The arguments are not persuasive. Goldberg et al. teaches the composition may comprise 12-30% of "wax" wherein the wax may be a mixture of many waxes, including petrolatum. Using less than 1% of petrolatum as part of the "wax" is seen to be obvious. Note the examiner did not "redefine" "wax." The definition of "wax" was found in Goldberg et al.

Finally, applicants allege an unexpected benefit residing in the claimed invention. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e). The examiner did not find proper support from the application to substantiate the alleged unexpected benefit.

No claim is allowable.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
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